

**REMARKS**

Claims 1-13 have been examined. With this amendment, Applicant cancels claim 2.

Claims 1 and 3-13 are all the claims pending in the application.

**I. Formalities**

Applicant thanks the Examiner for acknowledging the Request for Continued Examination filed on January 3, 2005, and for indicating that this submission has been entered.

**II. Claim Rejections - 35 U.S.C. § 102**

The Examiner has rejected claims 1, 2, 4, 5 and 7-13 under 35 U.S.C. § 102(e) as being anticipated by McIntyre *et al.* (US 6,149,256) [“McIntyre”]. For at least the following reasons, Applicant traverses the rejection.

Claim 1, as amended, recites an electronic camera that comprises where “the recording material is a photographic material.” The Examiner provides inconsistent analyses in rejecting the claimed subject matter. On page 4 of the Office Action, the Examiner contends that Photomedia listed in Table 1 of McIntyre corresponds to the claimed photographic material, but on page 7 of the Office Action, the Examiner concedes that McIntyre does not disclose a recording material that is photographic and applies Aoto *et al.* (US 6,515,761) [“Aoto”] to allegedly cure the deficiency. Applicants request that the Examiner clarify his position. However, Applicant submits that McIntyre does not disclose the claimed photographic material.

McIntyre discloses a printer cartridge for use with an ink jet printer (Abstract). McIntyre also discloses that the media quality of cartridge 10 may be Photomedia. However, Applicant submits that Photomedia only refers to the quality of the media, not the type of media, i.e.

whether the media is photographic. In fact, the media in McIntyre cannot be photographic since the printer is an ink jet. Accordingly, McIntyre does not disclose or suggest the claimed photographic material.

With respect to the rejection of the claimed photographic material using the combination of McIntyre and Aoto, the Examiner contends that this combination would have been obvious to one skilled in the art because it “would simplify the printer circuit since there is no need for color ribbons or color inks” and the photographic paper would “produce a hard copy for a pickup image captured by the camera section.” Office Action at page 7.

McIntyre discloses an insertable cartridge for an ink jet printer of a digital camera (Abstract). There is no disclosure or suggestion that the cartridge may be adaptable to an LED printer. In fact, there is no disclosure of the specifics of the ink jet printer itself or its interface with the digital camera since McIntyre only relates to the insertable cartridge. Accordingly, there are no teachings related to a printer circuit nor is there any disclosure in McIntyre or Aoto that suggests that a printer circuit of an LED printer is simpler than an ink jet printer. Accordingly, there is no support in the prior art for the Examiner’s speculation that printer circuits for LEDs are simpler than printer circuits for ink jet printers.

In addition, the ink jet printer in McIntyre already produces a hard copy image. Therefore, the suggestion to modify based on this feature is also not supported. Accordingly, the Examiner’s proffered reasons to combine, which appears to be mere speculations, are not evidence in the record as required by *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

Mere “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). “[T]here must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” *Id.* Here, there is no motivation or suggestion in the teachings of McIntyre and Aoto that modifying the printer of McIntyre to incorporate photographic paper is desirable. Accordingly, the Examiner has failed to make a *prima facie* case of obviousness.

Applicant submits that claims 10, 11 and 13 are patentable at least by virtue of their dependency on claim 1.

Claim 4 recites an electronic still camera where “the second power source [for supplying the printer section] has a larger capacity than the first power source [for supplying the camera section].” The Examiner contends that this feature is inherent because the batteries used for the printer operate mechanical devices while printing whereas the batteries for a digital camera are used only for electronic circuitry. Office Action at page 4.

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.” MPEP at 2100-54 (emphasis in original). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the ... the reference.” *Id.* “Inherency, however, may not be established by probabilities or possibilities.” *Id.* Here, it is quite clear that the Examiner is merely speculating.

The system of McIntyre does not make clear that the printer power source necessarily has a larger capacity than the camera power source. For example, there is no disclosure of the design operational times for the printer and camera in McIntyre. Because the operational time is also a factor in determining capacity, the mere fact that a camera may consume less power for a given period of time than a printer does not necessarily mean that the power source for the camera has a smaller capacity than that of the printer. For example, camera 11 may be designed to operate for a much longer period of time than printer 13, which would necessitate a larger battery. Accordingly, the Examiner's reliance on inherency is misplaced.

In addition, the Examiner is ignoring other components of a digital camera such as motors for zoom operation, LCD screens and flashes that rely on the camera battery. In designing for these components, Applicants submit that it is possible that the camera may need to have a larger capacity power source than that of the printer.

Applicant submits that claims 5 and 6 are patentable at least by virtue of their dependency on claim 4.

In addition, the Examiner rejects claim 6 under 35 U.S.C. § 103 as being unpatentable over McIntyre. Claim 6 recites that "the second power source is constituted of batteries of a type that is compatible with a battery for the first power source." The Examiner takes official notice that the battery type used in the printer 13 is AA because the camera 11 allegedly uses AA batteries. The Examiner contends that it would have been obvious to use the same size battery in cartridge 10 as that of the camera because the batteries could be easily obtained from the market place and because the replacement of batteries in the printer and camera would be convenient.

Applicant submits that the design of batteries requires consideration of factors such as voltage and current requirements of the components, the space requirements for the batteries and the design operational time period to name just a few. Although factors such as availability in the market place and convenience may be considered, these factors do not make a *prima facie* case of obvious that the batteries of the camera are compatible with the printer. If this was the case, all cameras and printers would have the same type of batteries and this is clearly not the case.

In addition, “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work.” MPEP at 2100-136 (emphasis in original). Here, the Examiner takes Official Notice of AA batteries in the printer by using a User’s Guide for a camera. This is clearly improper since the issue relates to the compatibility of the printer battery and the camera battery. The Examiner must cite to a prior art reference that discloses that printers, which are attached to cameras, always have batteries compatible to the cameras in order for the Official Notice to be valid. Since the Examiner has not provided such a prior art reference and only relies on unsupported speculations, Applicant submits that the Examiner’s Office Notice is invalid, and the Examiner has failed to make a *prima facie* rejection of claim 6.

Claim 7 recites an electronic still camera that comprises “a switching device for connecting the second power source to the camera section in order to supply power to the camera

section, and for connecting the first power source to the printer section in order to supply power to the printer section.” The Examiner contends that this limitation is met because Fig. 5 shows a connection between camera 11 and batteries 34 and 50.

Applicants submit that Fig. 5 also shows the configuration used by the Examiner in contending that the feature “a power source section comprising a first power source for supplying the camera section and a second power source for supplying the printer section separately from each other” as set forth in claim 1 was disclosed. Accordingly, the Examiner’s interpretation of the elements between claims appears to be shifting since this connection, which was once separate between the power sources, is now interpreted as connected between the power sources. Applicant submits that this shift in interpretation is improper.

However, for the sake of expediting prosecution, Applicant has further clarified claim 7 to recite that the claimed connection is for supplying power from one source to the other section. Applicant submits that McIntyre does not disclose or suggest a switching device for connecting the power source of the camera 11 to the printer 13 in order to supply power to the printer section or for connecting the power source of the printer 13 to the camera 11 in order to supply power to the camera 11. In fact, McIntyre arguably teaches the opposite (see col. 2, lines 10-15 and col. 4, lines 46-54 and lines 63-67).

Applicant submits that claim 8 is patentable at least by virtue of its dependency on claim 7.

Claim 12 recites that the printer is incorporated into the camera housing. The Examiner contends that this feature is disclosed when the cartridge 10 is inserted into slot 10b. Applicant disagrees.

McIntyre discloses a printer 13 that is incorporated into a housing that is separate from the housing of the camera 11 (Fig. 6). These housings are clearly separate as is illustrated by Kodak Digital Science, DC220 and DC260 Zoom Camera, User's Guide. Since slot 10b is in the housing of printer 13 and not camera 11, McIntyre does not disclose or suggest this feature.

Although the claims should be given the broadest reasonable interpretation, the broadest reasonable interpretation must also be consistent with the interpretation that one skilled in the art would reach. MPEP at 2100-47. Here, it is clear that the components of the camera 11 are incorporated on one housing and the components of printer 13 are in a separate housing. Accordingly, McIntyre does not disclose or suggest the features in claim 12.

### **III. Claim Rejections - 35 U.S.C. § 103**

The Examiner has rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over McIntyre in View of Aoto *et al.* (US 6,515,761) ["Aoto"]. For at least the following reasons, Applicants traverse the rejection.

Claim 2 has been canceled.

Applicants submit that claim 3 is patentable at least by virtue of its dependency on claim 1. In addition, claim 3 recites that "the printer section comprises a printing head that projects light onto the photographic material across a line in accordance with the image data while

moving relative to the photographic material.” The Examiner concedes that this feature is not disclosed by McIntyre in View of Aoto but applies an Official Notice to cure the deficiency.

The Examiner speculates that the claimed feature would have been obvious to one skilled in the art because moving the print head relative to the paper would simplify the printer circuits because of the reduction in rollers used for transporting the paper to the print head. Office Action at page 8. Applicant disagrees.

Aoto discloses that the photographic paper 21 is transported by the conveying unit 260 past the exposure unit 270 (print head) as the paper 21 is ejected out of aperture 227. McIntyre does not disclose the details of printer 13, but Fig. 8 appears to indicate a process similar to that of Aoto, i.e. the paper is transported to a stationary print head while being ejected out of the cartridge. Because both systems require that the paper be transported out of the their respective cartridges and because the rollers needed transport the paper out of the cartridge also transport the paper to the print head, the Examiner’s contention that rollers will be reduced is not supported. In fact, additional motors and rollers will be needed to move the print head. Accordingly, the Examiner’s proffered reason is not supported by the prior art as required by the MPEP.

In addition, since printer design qualifies as esoteric technology, the Examiner’s use of Official Notice is improper. See MPEP at 2100-136 (requiring citation to referenced work in areas of esoteric technology).



**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

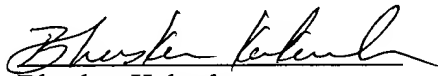
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